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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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GREENBLUM & BERNSTEIN PLC
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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT PAPER NUMBER

2622

DATE MAILED: 02/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/314,960

Applicant(s)

IIDA, JUNICHI

Examiner

Joseph R. Pokrzywa

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—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 27 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

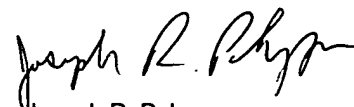
Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 20-26, 28-31, 39-45, 47-49 and 57-69.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____



Joseph R. Pokrzywa
Examiner
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DETAILED ACTION

Period for Reply

1. The shortened statutory period for reply expires THREE MONTHS from the mailing date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

Response to Amendment

2. The amendment filed 12/27/04 under 37 CFR 1.116 in reply to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

Allowed claim(s): none

Rejected claim(s): 20-26, 28-31, 39-45, 47-49, and 57-69

Claim(s) objected to: none

Response to Arguments

3. Applicant's arguments filed 12/27/04 have been fully considered but they are not persuasive.
4. In response to applicant's arguments regarding now amended **claim 20**, having the limitations of now canceled claim 27 included in the claim, whereby claim 27 was rejected as being unpatentable over Endo (U.S. Patent Number 6,801,340) in view of Huang *et al.* (U.S. Patent Application Publication US 2003/0097361). The examiner notes that claim 20 now includes the limitation "said communicator transmitting the address book and menu items to the terminal apparatus, wherein the address book and the menu items are displayed as a single image at the terminal apparatus, the menu items being utilized to change a content of the address book".
5. In the Office action dated 10/26/04, the examiner cited portions of Huang that teach these features. Upon further review of Huang, the examiner still believes that Huang can be interpreted as teaching these features. Particularly, as seen in Figs. 5A and 5B, a view of an address book is shown that was transmitted to the terminal apparatus. In the figure, menu items are shown at the top of the HTML page (My Address Book and New Address) and near the bottom of the HTML page (Add to Recipients 514, Mail 512, and Search 516). Further, as read in paragraph 0074, the user can "click on button 514 to add the selected address(es) to the recipient filed of the e-mail message". Also, as read in paragraph 0072, a "user can retrieve additional information for a particular name in desktop 260 by simply clicking on that name." Thus, as seen in the top of Fig. 5A, a user can click on button 514, which would then add the name to the recipient of an e-mail, seen on the bottom of Fig. 5A. Continuing, as seen in the top of Fig. 5B, in an e-mail, a user can click on the name "alinac@ucla...", bringing them to a screen 540. As read in paragraph 0076,

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within window 540 of Fig. 5B, a user can “choose to enter additional information to be associated with the selected address or group of addresses, including the short name, contact telephone, and other information.... The information window 540 is updated to the address book, as shown by an address book window 550.” Therefore, window 540 is used to change or alter addresses stored in the address book. Because the various menu items are used to initiate this window, one of ordinary skill in the art can recognize that menu items are being utilized to change a content of the address book, as is currently required in the claim. While the specific menu items of the current application (seen in Fig. 18, being “Add”, “Delete”, “Edit”, and “Home”) are different than what is taught and discussed above in Huang, one of ordinary skill in the art can recognize that Huang’s address book and menu items are displayed as a single image at the terminal apparatus, with the menu items being utilized to change a content of the address book.

6. In response to applicant’s arguments on pages 13 and 14, stating that there is no proper basis for the combination of Endo and Huang., and that there is no proper motivation for combining the teachings of the two references. As discussed in the Office action dated 10/26/04, the motivation for combining Endo and Huang would have been that Endo’s address book would become globally accessible from any computer, as recognized by Huang in paragraph 0108, which states that the user would be able to have global access from any location through a familiar desktop, therein enhancing efficiency and improving productivity. Thus, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have the global access teachings of Huang in the system of Endo, thereby allowing transmission of the address

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book and at least one input screen in response to an instruction from the terminal apparatus, with the address book and menu items being displayed as a single image at the terminal apparatus, and the menu items being utilized to change a content of the address book.

7. Therefore, for theses reasons, the rejection of **claims 20 and 39**, as are currently amended, would continue to be unpatentable over the combination of Endo and Huang *et al.*, as cited in the Office action dated 10/26/04 with respect to claims 27 and 46.

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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622



jrp